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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,563	08/02/2000	Keiichi Nakajima	PM 271791 NI-0006PCTUS	9970
909	7590	05/09/2006	EXAMINER POND, ROBERT M.	
PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			ART UNIT 3625	PAPER NUMBER

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,563

Applicant(s)

NAKAJIMA, KEIICHI

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4 and 36-94 is/are pending in the application.
- 4a) Of the above claim(s) 53-62 and 76-94 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,36-52 and 63-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election by Original Presentation

Newly submitted claims 53-62 and 76-94 and amended dependent claims 12-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: actual cashier registering requiring clerk assistance. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 76-94 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Amendment

The Applicant canceled all independent claims and newly added independent claims. Claims 1, 3, 5-11, and 20-35 were canceled. All pending claims 2, 4, 36-52, and 63-75 were examined in this final office action. The Examiner is suggesting the Applicant consider a telephonic interview for further discussion prior to formal reply.

Response to Arguments

Applicant's arguments filed 10 January 2006 have been fully considered but they are not persuasive. Mobile Commerce discloses methods of using cellular

telephones as paying terminals, paying terminals interacting with computers managing database records, transacting electronic commerce (i.e. purchasing tickets), and paying bills electronically. Mobile Commerce teaches industry movement to telephony-based Internet commerce in order to capture a growing based of mobile phone users and investigating payment systems. Payne teaches a payment system, billing and settlement. The combination of Mobile Commerce and Payne is properly motivated given that Mobile Commerce teaches payment systems being investigated for use in the mobile commerce model. Payne discloses a payment system known by one of ordinary skill in the art as being used in the industry.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 2, 4, 36-52, and 63-75 are rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (Paper #7, PTO-892, Items: U and V), in view of Payne (US 5,715,314, which incorporates in its entirety "Digital Active Advertising" serial no. 08/168,519, now abandoned, thereby**

incorporating in its entirety US 5,724,424 "Digital Active Advertising" a continuation of serial no. 08/168,519).

Mobile Commerce teaches turning the cellular phone into an electronic purse handling case, loyalty points, tickets, and identification (please note: cellular phone connects to commerce system using RF communications network). Mobile Commerce teaches mobile commerce attracting 5 million consumers desiring to use mobile commerce. Mobile Commerce further teaches:

- A paying terminal database: cellular phone as a paying terminal; Inherent in Mobile Commerce are the structures necessary to permit storing paying terminal information in a database. For example, the users cellular phone is in communication with a service receiving access codes from the user who is authorizing secure payments or transfers to other accounts, paying bills or checking account balances, and using smart cards to securely access banking services (Paper #7, PTO-892, Item: U, see pages 1 and 2). Organizing customer data in a database is fundamental.

Mobile Commerce teaches all the above as noted under the 103(a) rejection and further teaches the Mobile Commerce forum investigating integrating payment systems with mobile telecommunications (Paper #7, PTO-892, Item: V, see at least page 2), but does not disclose any details on what types of payment systems are being investigated. Payne teaches a payment system to support electronic commerce. Payne teaches consumers (buyers) purchasing electronic content and/or hard goods over a payment system comprising buyer computers,

merchant computers, and a payment computer with access to a settlement database and a shopping cart database (see at least Fig. 1). Payne teaches advertise product. Payne further teaches:

- Establishing communication to a billing terminal (e.g. cashier server, virtual register) based on information identifying the billing terminal: user terminal is in communication with payment computer (comprising a settlement database) that communicates with a real-time financial authorization network (see at least Fig. 13 (300); col. 7, line 65 through col. 8, line 7).
 - Setting a transaction identifying number to identify an order transaction of an item; user ID: buyer computer sends payment computer payment URL A which comprises a product identifier, domain identifier that represents a domain of products to which the desired product belongs (please note examiner's interpretation: a catalog number, an advertising promotion number, etc), a merchant computer identifier, merchant account identifier, payment amount (see at least Fig. 2A (34); col. 5, lines 26-47);
 - Paying terminal transmits the information identifying the billing terminal to the settlement apparatus: Inherent in Payne are the structures necessary to permit the paying terminal to identify the billing terminal to the settlement apparatus. For example, the user supplies credit card account information that identifies the credit card company used to

check credit status (see at least Fig. 2G (76); Fig. 7; col. 7, lines 14-17).

- Transmitting information about the billing terminal with the transaction identifying number to the paying terminal: (see at least Fig. 2C (44); Fig. 6; col. 6, lines 9-14).
- Synchronizing a communication to the billing terminal with a communication to the paying terminal when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number as a user input information to the settlement apparatus: (see at least Fig. 2C (62); col. 6, lines 30-59).
- Transmitting a synchronization confirmation signal which indicates that the synchronization is established with the billing terminal: Inherent in Payne are the structures necessary to permit synchronization between paying terminal (user terminal) processes, billing processes, and settlement processes.
- Receiving the order of the item from the paying terminal: payment computer receives order by buyer (see at least Fig. 2A (32, 34); col. 5, lines 26-30).
- Transmitting the order of the item received from the paying terminal to the billing terminal:
- Receiving a purchase amount based on the order of the item from the billing terminal: payment URL from buyer indicates payment amount that

include price of product; actual amount (see at least col. 5, lines 30-35; col. 7, lines 5-30).

- Performing a process of settlement of the transaction between the billing terminal and the paying terminal, both of which are synchronized with each other by the transaction identifying number based on the purchase amount: performs settlement using a transaction detail URL that includes a transaction identifier, a buyer network address, and a transaction detail URL authenticator (see at least col. 9, lines 3-18).
- System: computers providing a) user interface and communications over the Internet, b) billing, credit checking, account management, and settlement processing; merchant product information (see at least Fig. 1).
- Computer readable medium: Inherent in Payne are the structures necessary to permit the embodiment of computer instruction code into computer readable medium executable by computers that comprise the network sales system.
- Communication units: Inherent in Payne are the structures necessary to permit communication between computers connected to the network.
- Paying terminal: buyer computer (see Fig. 1 (12, 14)).
- Billing terminal: payment computer performs billing functions (see Fig. 1 (16, 22)).
- Settlement apparatus: computer structures necessary to manage settlement database (see Fig. 1 (22)).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Mobile Commerce to integrate a payment system that integrates billing and settlement as taught by Payne, in order to provide mobile commerce users with same or similar billing and settlement processing as provided for buyer computers directly connected to the Internet, and thereby increase sales for merchants by capturing approximately 5 million mobile telephone users.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

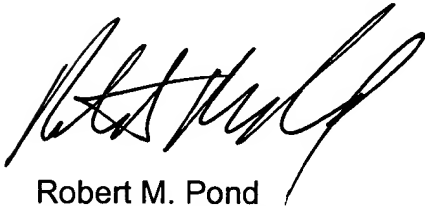
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Yogesh Garg can be reached on 571-272-6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. M. Pond', written in a cursive style.

Robert M. Pond
Primary Examiner
May 4, 2006